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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,697	04/05/2002	Akane Takemura	011633	3246

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EXAMINER

PORTER, RACHEL L

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,697

Applicant(s)

TAKEMURA ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 4/5/2002. Claims 1-10 and 12-22 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, and 12-22 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

As per exemplary claim 1, it is unclear as to which recognized statutory class of invention the recited "risk improvement table" is directed. In particular, a "risk improvement table" is not a process or method, as it lacks a series of steps. As currently recited, in claim 1 and its dependent claims, the "risk table" appears to be data, per se.

Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (*State Street Bank & Trust Co. vs. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

MPEP 2105 offers the following guidance:

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer- readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some “real world” value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

In the instant case, the recited “risk improve table” is apparently a compilation of data. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such “descriptive material” is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that

data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).) (See MPEP 2105).

In light of the above, it is respectfully submitted that the claimed invention of exemplary claim 1, is not does not useful, tangible, and concrete result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

A similar analysis maybe applied to claims 2-5, and 12-22.

Also, a similar analysis may be applied to claim 7 with its recitation of "a risk care set" comprising a risk improvement table and risk improvement tools.

3. Claim 6 provides for the use of the risk improvement table, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. Claim 8 provides for the use of the risk improvement table, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 and 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-10 and 12-22, it is unclear to the examiner which statutory class of invention the current claims are directed toward. Consequently, it is unclear how the addition limitations and wherein clauses are intended to further limit the recited "risk assessment table." In particular, it is unclear whether the table is part of a graphical

user interface as suggested by claim 3, or a software component (as suggested by exemplary claims 2 and 14).

As per claim 6, the current claim recites a method using the table. However, the claim fails to outline any steps, which would produce any results or outcomes.

Therefore the scope of the current claim and the “use of the risk improvement table” are vague and indefinite.

A similar analysis may be applied to claim 8.

As per claim 7, it is unclear to the examiner, what statutory claim of invention “a risk care set” which comprises a risk improvement table and a risk improvement tools. For examination purposes, the Examiner will interpret these limitations as data per se and apply are accordingly.

As per claim 9, the preamble recites “a risk improvement table creation method...” However, it is noted that the steps recited do not result in creation of a risk table. Therefore, it is unclear how the claimed method and steps correlate to the recited intention of the method, and how the recited steps create a risk improvement table.

As per claim 10, it is unclear as to which a statutory class of invention the applicant intends to claim. While the preamble recites a “system,” the body of the claim recites a combination of possible components (examination means, calculating means); steps (an operation and descriptive material (the risk table, and risk improvement tools (i.e. software with no interrelationship to a computer to have its functionality realized.

Claims 2-5 and 12-22 inherit the deficiencies of claim 1 through dependency and are also rejected.

NOTE: In light of the extensive 112 2nd problems, the examiner is interpreting the claims and applying prior art as best possible using these interpretations. These interpretations of claim language are for examination purposes only.

NOTE: The following art rejections assume that the subject matter of claims 1-8 and 12-22 will be amended to recite statutory subject matter. The art rejections are provided hereinbelow for the Applicant's consideration on the condition that the Applicant properly incorporates concrete and tangible elements as discussed above in the rejections under 35 U.S.C. 101 in the next communication sent in response to the present Office Action.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-10 and 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Connelly (US 5,738,113 A)

Connelly discloses a system and method for evaluating the risk of developing oral disease, namely oral cavities. (abstract). Connelly further discloses a method of testing patients for the presence of specific bacteria and developing a risk table to improve diagnosis and treatment rates (Abstract, Table 1; col. 4, lines 4-29) Connelly

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also discloses several risk improvement tables which provide information regarding what patients at various risk levels can do with treatment and behavioral modification to reduce their risk of developing dental caries, and cavities. (Tables 2-4).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- Sachdeva (US 7,003,472) discloses a dental patient treatment plan.
- Singer, Jr. (US 5,376,532) discloses a method for evaluating risk of dental diseases.
- Steinberg et al (US 6,025,326) discloses a system of charting methods for treatments of oral diseases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP
RP

Carolyn Bleck
Patent Examiner
3626
10/2/06